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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/192,583	11/17/1998	TETSURO MOTOYAMA	5244-0084-2X	9978
22850	7590	03/07/2006	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			HO, CHUONG T	
			ART UNIT	PAPER NUMBER
			2664	

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No.		Applicant(s)	
	09/192,583		MOTOYAMA, TETSURO	
	Examiner		Art Unit	
	CHUONG T. HO		2664	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/31/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. The amendment filed 01/12/06 have been entered and made of record.
2. Applicant's arguments with respect to claims 1-53 have been considered but are moot in view of the new ground(s) of rejection.
3. Claims 1-53 is pending.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 8-10, 12-15, 23-26, 31-32, 34-37, 45-46, 48, 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaridis et al. (U.S. Patent No. 6,219,694 B1) in view of Motoyama (U.S. Patent No. 5,412,779).

In the claims 1, 23, Lazaridis et al. discloses determining a system for pushing information from a host system (a computer) to a mobile data communication device (a business device) upon sensing a triggering event is disclosed (see abstract). A redirector program operating at the host system (a computer) enables a user to continuously redirect certain user's mobile data communication device upon detecting the one or more user-defined triggering events has occurred (see abstract); A list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a

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filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message (see col. 8, lines 9-11); comprising:

- Receiving an electronic mail message by a computer; determining whether a content of the message (the word "instruction" is the characteristic of the e-mail) is for a user (user's desktop system 10) or for an attached device (a mobile data communication device) associated with the computer by detecting a characteristic of the e-mail, the attached device being a business office device (a mobile data communication device) including a processor (see abstract, col. 8, lines 9-11);
- transmitting a communication from the computer (user's desktop system 10) to the attached device (a mobile data communication device) (see abstract, determining a system for pushing information from a host system (a computer) to a mobile data communication device (a business device) upon sensing a triggering event is disclosed (see abstract). A redirector program operating at the host system (a computer) enables a user to continuously redirect certain user's mobile data communication device upon detecting the one or more user-defined triggering events has occurred (see abstract); (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data

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item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message);

- operating the processor of the attached device (a mobile data communication device) in response to the communication (once the message (A or B) is received by the mobile device 24), the outer envelope B is removed and the original message A is placed in the secondary memory store within the mobile device 24. By repacking and removing the outer envelope in this manner, the present invention causes the mobile computer 24 to appear to be at the same physical location as the host system 10, thus creating a transparent system).

However, Lazaridis et al. is silent to disclosing control of attached image printing device (copier engine) associated with the computer (user); and transmitting a communication from the computer (user) to the attached image printing device (copier engine).

Motoyama (U.S. Patent No. 5,412,779) discloses control of attached image printing device (copier engine 10) associated with the computer (optional panel 20); and transmitting a communication from the computer (optional panel 20) to the attached image printing device (copier engine 10) (see figure 1, col. 3, lines 3-6, if abnormal states are detected, System Control Processor 102 sends data to Communication 101, which codes data and sends the coded data to the Operation panel 20 through communication media line 12).

Both Lazaridis et al. and Motoyama discloses controlling and communicating with business office devices. Motoyama recognizes control of attached image printing device

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(copier engine 10) associated with the computer (optional panel 20); and transmitting a communication from the computer (optional panel 20) to the attached image printing device (copier engine 10). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Lazaridis with the teaching of Motoyama to provide control of attached image printing device (copier engine 10) associated with the computer (optional panel 20); and transmitting a communication from the computer (optional panel 20) to the attached image printing device in order to diagnose of troubles in such devices.

6. In the claims 2, 24, 34, Lazaridis et al. discloses determining whether the received message includes instructions (the word "instruction" is the characteristic of the e-mail) for operating the device or whether the received message which has been received has been received has a user of the computer as an end recipient (see abstract, col. 8, lines 9-11).

7. In the claims 3, 25, Lazaridis discloses displaying, after the receiving step, a message to the user indicating the electronic mail message contains information to be forward to the device, wherein the determining step comprises: determining by a user reading the displayed message whether the received message includes instructions (the word "instruction" is the characteristic of the e-mail) is for operating the device (see abstract, col. 8, lines 9-11).

8. In the claim 8, Lazaridis et al. discloses receiving an Internet electronic mail message (see abstract, col. 8, lines 9-11, figure 1).

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9. In the claim 12, Lazaridis et al. discloses determining whether the message is for the user (the user's desktop system 10) or for the attached device automatically by detecting a characteristic (the word "instruction" is the characteristic of the e-mail) (see abstract, col. 8, lines 9-11).

10. In the claim 45, Lazaridis et al. discloses receiving data from the device, in response to the step of operating the processor; creating an electronic mail message (repackage the user-selected data items in an electronic wrapper prior to push the data items to the mobile device) by computer (the user's desktop system 10) including the data which has been received; and transmitting over the Internet the electronic mail message generated by the computer.

11. In the claims 46, 31, 50, 51, Lazaridis et al. discloses executing, by a device driver of the computer, commands for at least one of controlling and monitoring the device (see col. 1, lines 11-15, the system and method of the present invention provide an event-driven redirection computer program ("redirector program") operating at the host system, which, upon sensing a particular user-defined event has occurred, redirects user-selected data items from the host system to the user's mobile data communication device (Business office device including CPU) (col. 7, lines 14-15).

12. In the claims 4, 48, 26, 32, Motoyama, see figure 1, discloses Executing a command which causes the step of transmitting to be performed (see figure 1, col. 3, lines 15-20).

13. In the claims 9, 27, Lazaridis discloses the step of executing a command comprises transmitting information to a device driver executing within the computer; and step of transmitting is performed using the device driver (see col. 1, lines 13-16).

14. In the claim 10, Lazaridis discloses receiving, by the device, the communication transmitted from the computer; and transmitting parameters from the device to the computer, in response to the communication which has been received by the device (see col. 6, lines 42-45).

15. In the claims 13, 35, 36, 37, 52, Lazaridis discloses determining that the message for operating the attached device automatically by detecting a code within the message (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message).

16. In the claim 14, Lazaridis discloses determining that the message for operating the attached device automatically by detecting a code which is the subject of the message (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has

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certain message characteristics that if present will trigger or suppress redirection of the message).

17. In the claim 15, Lazaridis discloses determining that the message is for the attached device automatically by detecting a code within the message (see col. 8, lines 9-11, a list of message characteristics that determine whether a message is to be redirected. If activated, the preferred list mode causes the redirector program 12 to operate like a filter, only redirecting certain user data items based on whether the data item was sent from a sender on the preferred list or has certain message characteristics that if present will trigger or suppress redirection of the message).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 5-7, 11, 16-17, 27-29, 30, 47, 33, 38-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Lazaridis – Motoyama) in view of Zerber (U.S. Patent No. 5,951,636).

In the claims 5, 6, 7, 27, 33, the combined system (Lazaridis – Motoyama) discloses the limitations of claim 1 above.

However, the combined system (Lazaridis – Motoyama) is silent to disclosing the executing program code of a file which is attached to the message by a manual action by the user.

Zerber discloses executing program code of a file which is attached to the message by a manual action by the user (see abstract).

Both Lazaridis, Motoyama, and Zerber discloses e-mail message. Zerber discloses executing program code of a file which is attached to the message by a manual action by the user. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis – Motoyama) with the teaching of Zerber to executing program code of a file which is attached to the message by a manual action in order to limit to only those messages the user want to downloaded.

20. Regarding to claims 6, 29, Zerber et al. discloses executing the program code of the file by pointing, using a pointing device and graphical user interface, to an object representing the file (see abstract).

21. Regarding to claims 7, 28, Zerber et al. discloses executing the code by pressing a button while pointing the object representing the file (see abstract).

22. Regarding to claim 11, Zerber et al. performing a mechanical action by the device, in response to the communication which has been received by the device (see abstract).

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23. Regarding to claims 16, 17, 30, 38, 39, Zerber et al. discloses the determining step is performed in response to a receipt of an incoming electronic mail message (see col. 2, lines 30-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

24. Claim 47 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Lazaridis – Motoyama) in view of Miyachi (U.S. Patent No. 6,108,492).

Regarding to claim 47, the combined system (Lazaridis - Motoyama) discloses the limitations of claim 1 above.

However, the combined system (Lazaridis - Motoyama) is silent to disclosing the business office device at least one of generates an image on a recording medium and scans an image on a recording medium.

Miyachi discloses wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium (see col. 2, lines 27-35).

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Both Lazaridis, Motoyama, and Miyachi disclose the office device. Miyachi discloses the business office device at least one of generates an image on a recording medium and scans an image on a recording medium. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Lazaridis - Motoyama) with the teaching of Miyachi to provide the business office device at least one of generates an image on a recording medium and scans an image on a recording medium in order to carry out remote diagnose of troubles in business communication devices.

Claim Rejections - 35 USC § 103

25. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

26. Claims 18, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kuwabara (U.S. Patent No. 6,065,136) in view of Motoyama. (U.S. Patent No. 5,412,779).

Regarding to claims 18, 40, see figure 1, Kuwabara discloses transmitting device status (see col. 5, lines 15-17) information from a device (main part 11) to a computer (computer part C1) attached to the device (main part 11); comprising:

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- Transmitting state information of an device from the device (User A) to a first computer (provider 5) directly attached to the device (User A); processing the state information by software component within the first computer (provider 5, see figure 1, col. 5, lines 32-37); transmitting by the first computer (provider 5, processed state information over the Internet to a monitoring second computer (provider 8, see figure 1).

However, Kuwabara is silent to disclosing transmitting state information including at least one of static, semi-static, and dynamic states of an image printing device from the image printing device to a first computer, the image printing device including a processor.

Motoyama discloses transmitting state information including at least one of static, semi-static, and dynamic states of an image printing device (see 106, 107, figure 1, col. 3, lines 15-20) from the image printing device (copier engine 10) to a first computer (optional panel 20), the image printing device including a processor (see 102, figure 1)

Both Kuwabara, and Motoyama discloses device status information. Motoyama recognizes transmitting state information including at least one of static, semi-static, and dynamic states of an image printing device (see 106, 107, figure 1, col. 3, lines 15-20) from the image printing device (copier engine 10) to a first computer (optional panel 20), the image printing device including a processor (see 102, figure 1). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system of Kuwabara with the teaching of Motoyama to provide state information including at least one of static, semi-static, and dynamic states of an image printing

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device from the image printing device to a first computer, the image printing device including a processor in order to send out the status information to the user via e-mail.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

27. Claims 19-22, 41-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Kuwabara – Motoyama) in view of Lazaridis et al. (U.S. Patent No. 6,219,694 B1).

Regarding to claims 19, 41, the combined system (Kuwabara – Motoyama) discloses the limitations of claims 18, 40 above.

However, the combined system (Kuwabara – Motoyama) is silent to disclosing transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI.

Lazaridis et al. discloses transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the

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information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI (see col. 7, lines 31-45).

Both Kuwabara, Motoyama, Lazaridis discloses the an electronic message transmitting from computer to device. Lazaridis recognizes transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Kuwabara – Motoyama) with the teaching of Lazaridis to transmit transmitting the information from the device driver to a messaging application program interface (MAPI) of the computer; and processing the information by the MAPI, wherein the step of transmitting the electronic mail message comprises transmitting the electronic mail message corresponding to the information which has been processed by the MAPI in order to delivery of the data items from the host system of the device.

28. Regarding to claims 20, 42, Lazaridis et al. discloses the computer is a message transfer agent, the step of transmitting information from the device transmit the information from the device directly to the computer which is the message transfer agent, and the step of transmitting the electronic mail message transmits the electronic mail message using a TCP connection from the computer which is a message transfer agent (see col. 8, lines 32-35).

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29. Regarding to claims 21, 43, Lazaridis et al. discloses creating a file corresponding to the information; and writing the file to a mail spoon directory of the computer; and wherein the step of transmitting the electronic mail message comprising transmitting the electronic mail message corresponding to the information using the file stored in the mail spool directory (see col. 7, lines 35-37).

30. Regarding to claims 22, 44, Lazaridis et al. discloses creating and writing comprising creating a plurality of files and writing the plurality of files in the mail spool directory; and transmitting the electronic mail message using each of the plurality of files stored in the mail spoon directory (see col. 7, lines 31-40).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 49, 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combined system (Kuwabara – Motoyama) in view of Miyachi (U.S. Patent No. 6,108,492).

Regarding to claims 49, 53, the combined system (Kuwabara – Motoyama) discloses the limitations of claim 18, 40 above.

However, the combined system (Kuwabara – Motoyama) is silent to disclosing the business office device at least one of generates an image on a recording medium and scans an image on a recording medium.

Miyachi discloses wherein the business office device at least one of generates an image on a recording medium and scans an image on a recording medium (see col. 2, lines 27-35).

Both Kuwabara, Motoyama, and Miyachi disclose the office device. Miyachi discloses the business office device at least one of generates an image on a recording medium and scans an image on a recording medium. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the combined system (Kuwabara – Motoyama) with the teaching of Miyachi to provide the business office device at least one of generates an image on a recording medium and scans an image on a recording medium in order to carry out remote diagnose of troubles in business communication devices.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHUONG T. HO whose telephone number is (571) 272-3133. The examiner can normally be reached on 8:00 am to 4:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

03/03/06



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